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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/382,242 08/24/99 ROBERTSON

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| EXAMINER |
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HM22/0606

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|-----------|--------------|
| ART UNIT  | PAPER NUMBER |

1652

*9*

DATE MAILED:

06/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/382,242

Applicant(s)

Robertson et al.

Examiner

Rebecca Prouty

Art Unit

1652



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Mar 19, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 21-26 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 21-26 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5,6

20) ☐ Other: \_\_\_\_\_

Art Unit: 1652

Claims 1-20 have been canceled. Claims 21-26 are at issue and are present for examination.

Applicant's election with traverse of SEQ ID NO:23 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the MPEP 803.04 recites that in most cases up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction and therefore, applicants submit that all the sequences should be examined together. Applicants traversal is not found persuasive for the following reasons:

Applicant is reminded that the MPEP recites **up to 10** distinct nucleotide sequences not **at least 10** nucleotide sequences, and while applicants assert that they are claiming no more than 10 independent and distinct sequences, they are in fact claiming many more than 10 independent and distinct sequences when one considers they are claiming any 15mer within each of SEQ ID NOS: 23-33 as well as well as many larger fragments of each of these nucleic acids. Thus applicants are claiming many more than 10 independent and distinct sequences. Thus these inventions are distinct for the reasons given previously.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1652

The disclosure is objected to because of the following informalities: the blanks on pages 2 and 5.

Appropriate correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,942,430. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the instant application are claiming common subject matter as follows: the nucleic acid of SEQ ID NO:23 and fragments thereof encoding peptides with esterase activity.

Art Unit: 1652

Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is confusing and indefinite in the recitation of "The oligonucleotide probe of Claim 24, wherein said probe comprises..." as this claim appears to be broader than the claim from which it depends. Claim 24 depends from Claim 21 which is limited to probes **consisting of** at least 15 contiguous nucleotides of SEQ ID NO:23 while the language of Claim 26 would appear to intend to include any polynucleotide **comprising** a 15mer thereof. As such the intended scope of all the claims is unclear.

Claim 26 is indefinite in the recitation of "hybridizes" as this term is unclear absent a statement of the conditions under which the hybridization reaction is preformed. Nucleic acids which will hybridize under some hybridization conditions will not necessarily hybridize under different conditions.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1652

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.


Claims 21, 22, and 26 are rejected under 35 U.S.C. 102(a or b) as being anticipated by GenBank Accession No. X86487 or Kim et al.

GenBank Accession No. X86487 and Kim et al. each teach the isolation of a gene having a nucleotide sequence comprising at least 15 nucleotides of the nucleotide sequence of SEQ ID NO:23, and vectors and host cells containing these genes. Bases 21-39 of the gene of GenBank Accession No. X86487 are identical to bases 360-378 of SEQ ID NO:23 and bases 5051-5069 of the gene of Kim et al. are identical to bases 505-523 of SEQ ID NO:23.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Rebecca Prouty  
Primary Examiner  
Art Unit 1652